REMARKS

Claims 1-14 and 16 are pending in the application, and claim 15 has been withdrawn. By the foregoing Amendment, the specification and claims 1, 4, 8, 9, 10, 12, 14 and 16 are amended. Based on the above Amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and withdraw them.

Objection to Specification

The specification is objected to as failing to provide proper antecedent basis for the vertically adjustable "member" set forth in claim 5 and the "method" set forth in claim 16. By the foregoing amendment, the specification has been amended in accordance with 37 C.F.R. 1.121(b) as follows.

The specification has been amended at page 4, third paragraph, lines 16 through 19 to state that automatic fill device 20 and overfill drain device 60 are connected to each other so that their height "within tank 12" can be simultaneously adjusted. The specification has been amended at page 4, fourth paragraph, line 21 to read: "By way of illustration and for exemplary purposes only, automatic fill device 20 and overfill drain device 60 can be mounted on an adjustable member, such as a platform or plate, 80 so that the height of automatic fill device 20 and overfill drain device 60 can be simultaneously adjusted via plate 80, as follows." This paragraph has also been amended to state that plate 80 is not permanently attached to first, second, third or fourth sides 12a, 12b, 12c, 12d of tank 12, and accordingly elevational movement of plate 80 relative to tank 12 is not restricted by any attachment to the tank. Applicant respectfully submits that these amendments do not introduce new subject matter. Rather, the amendments merely make explicit what is implicitly disclosed in the specification and drawings as filed, namely that the automatic fill device 20 and overfill drain device 60 are in a fixed relationship so that their elevational movement relative to the tank is not restricted by any attachment to the tank and their heights within the tank are simultaneously adjustable, which can be accomplished by numerous designs in which the devices are connected to each other (see original specification at page 4,

lines 16-23, Figs. 2-4), including an adjustable member such as a platform or plate.

The specification has also been amended at page 7, line 14 to read, "The desired water level is selected by the following method: providing a tank 12 that is in communication with pool 18 and that contains automatic fill device 20 and overfill drain device 60 in fixed relation to each other, wherein elevational movement of the automatic fill device 20 and overfill drain device 60 relative to tank 12 is not restricted by any attachment to tank 12, the heights of the automatic fill device 20 and overfill drain device 60 within the tank are adjustable and setting the height of one of the devices in the tank automatically sets the height of the other device in the tank, and simultaneously adjusting the height of automatic fill device 20 and overfill drain device 60 via plate 80 so that the valve 26 will be at the desired water level." Applicant respectfully submits that this amendment does not introduce new subject matter. It merely makes explicit what is implicitly disclosed in the specification as filed, namely a method of achieving a desired water level in a pool (see original specification at page 3, lines 16-19, page 5, lines 5-8 and 12-16, page 7, lines 14-21).

Accordingly, reconsideration and withdrawal of the objection are respectfully requested.

Rejection Under 35 U.S.C. § 112

Claims 13 and 14 were rejected in the initial Office Action dated August 8, 2003 under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification. As discussed above, the specification has been amended to state that automatic fill device 20 and overfill drain device 60 can be mounted on an adjustable member, such as a platform or plate 80. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejections Under 35 U.S.C. § 102(b)

Claims 1, 2, 4, 9 and 16 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,537,111 to Whitten, Jr. Claims 1, 2, 4-7 and 16 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,908,206 to Grewing. Claims 1-4, 8 and 16 have been rejected under 35 U.S.C. § 102(b) as being anticipated by 4,621,657 to St. Ledger.

To anticipate a claim, a single prior source must contain all its essential elements. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986) ("It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention, and that such a determination is one of fact.").

1. Whitten, Jr.

Claim 1, from which claim 2 depends, recites a tank in communication with a swimming pool that contains both an automatic fill device and an overfill drain device, wherein setting the height of one of the devices in the tank automatically sets the height of the other device in the tank for the purpose of obtaining a desired pool water level. By the foregoing amendment, claim 1 has been amended to clarify that elevational movement of the automatic fill and overfill devices relative to the tank are not restricted by any attachment to the tank, the heights of the automatic fill and overfill devices within the tank are selectively and simultaneously adjustable, and setting the height of one of the devices in the tank automatically sets the height of the other device in the tank. Similarly, independent claim 4, from which claims 5-7 depend, has been amended to clarify that the automatic fill device and overfill drain device are selectively movable for elevational adjustment relative to the tank.

In contrast, Whitten, Jr. is directed to a system for controlling water level using peripheral drainage gutters rather than a separate surge or level control tank (column 2, lines 10-17 and lines 54-67). Whitten, Jr.'s system includes a motor-operated valve 60 connected to a water-level control sensor 56 mounted in a housing 48 (column 5, lines 5-11). Sensor 56 has multiple probes (ground or reference probe G, low-limit probe A and high-limit probe B) for detecting water level (column 5, lines 17-31). If the water level rises above high-limit probe B, valve 60 closes until the overflow level drops below low-limit probe A (column 5, lines 66-72). If the water level rises above grill 20, a separate adjustable overflow drain is provided within housing 48. The overflow drain comprises a box 45 with frontal opening 53 and a sliding gate 46 (column 6, lines 4-19). The height of the upper edge 51 of sliding gate 46 can be adjusted by moving a handle 49 attached to the gate (column 6, lines 15-22). While the height of control sensor 56 may be set initially during installation as suggested by the Examiner, Whitten, Jr. does not teach or suggest that the height of the water-level control

sensor 56 (or valve 60) within the tank is adjustable. Rather, sensor 56 is attached to housing 48, and remains stationary. The length of the probes A, B determine desired water level. Moreover, Whitten, Jr. does not teach or suggest that the heights of sensor 56 and sliding gate 46 are simultaneously adjustable, that setting the height of sensor 56 or sliding gate 46 automatically sets the height of the other device in the tank to obtain a desired water level, or that sensor 56 (or valve 60) and box 45 containing sliding gate 46 are selectively movable for elevational adjustment relative to the tank. The height of sensor 56 within the tank is not adjustable. Sensor 56 remains stationary, and adjusting the height of sliding gate 46 does not set the height of sensor 56.

Claim 9 recites a skimmer comprising a positive pressure area, a relatively no flow chamber in communication with the positive pressure area, and an automatic fill device and an overfill drain device contained in the chamber, wherein the automatic fill device and overfill drain device are connected in a fixed relationship to each other. Claim 9 has been amended to clarify that movement of the automatic fill and overfill devices within the chamber is not restricted by any attachment to the chamber, the heights of the automatic fill and overfill devices within the chamber are simultaneously adjustable, and setting the height of one of the devices in the chamber automatically sets the height of the other device in the chamber. Similarly, claim 16 has been amended to clarify that the claimed a method of achieving a desired water level in a pool comprises the steps of providing a tank in communication with the pool containing an automatic fill device and an overfill drain device in fixed relation to each other, wherein movement of the devices in the tank is not restricted by any attachment to the tank, the heights of the devices within the tank are simultaneously adjustable and setting the height of one of the devices in the tank automatically sets the height of the other device in the tank, and simultaneously adjusting the height of the automatic fill device and the overfill drain device to the desired water level. Whitten, Jr. does not teach or suggest that the automatic fill and overfill drain devices are connected to each other or in a fixed relation to each other, as recited in claims 2, 4, 9 and 16, as amended. As illustrated in Whitten, Jr.'s Fig. 1, although sensor 56 and sliding gate 46 are both contained in housing 48, their movement within housing 48 is restricted by their attachment to housing 48, they are not

connected to each other or in fixed relation to each other so that their height within housing 48 is simultaneously adjustable, and setting the height of one does not automatically set the height of the other.

Whitten, Jr. does not teach every element of the claimed invention as recited in claims 1, 2, 4, 9 and 16 and therefore cannot anticipate the claimed invention.

2. Grewing

Independent claims 1 and 16 are amended to clarify that movement of the automatic fill device and overflow drain device within the tank is not restricted by any attachment to the tank and the heights of the devices within the tank are simultaneously adjustable. Independent claim 4 has been amended to clarify that the automatic fill device and overfill drain device are selectively movable for elevational adjustment relative to the tank.

Grewing teaches an automatic water level keeper including a tank 25 mounted on adjustable telescoping support legs 53, 54 (column 2, lines 57-65). Tank 25 contains a float valve 41 that senses the height of water level in the tank and an opening 35 in the tank wall for vent and overflow (column 2, lines 16-23). A separate overflow pipe 51 to drain off surplus water (column 2, lines 53-54). The heights of float valve 41, opening 35 and overflow pipe 51 within the tank are fixed, not adjustable, and setting the height of float valve 41 within tank 25 does not automatically set the height of the opening 35 or overflow pipe 51, or vice versa. Rather, "The operation of the float valve 41 is preferably established at the factory so that no additional adjustment of the float level is necessary." (column 2, lines 33-35). During operation, if the water level drops, float valve 41 opens and allows water to flow into the pool until the desired level is reached, and surplus water drains off through overflow pipe 51 in the pool wall (rather than through opening 35) (column 2, lines 47-54). To change the desired pool water level, one must raise or lower the entire tank 25 by adjusting the height of telescoping support legs 53, 54 (column 2, lines 57-62), rather than by simultaneously adjusting only the height of the float valve and overfill drain device within tank 25, as recited in claim 1, as amended, from which claims 2 and 4-7 depend, and claim 16, as amended.

Grewing specifically teaches away from adjusting the height of the float valve within the tank to obtain a desired water level. Rather, Grewing's entire tank 25 is mounted on an adjustable member 53, 54 and the height of the adjustable member is adjusted to change the height of the entire tank to achieve the desired water level, "without having to re-set a float valve." (column 4, line 1). Grewing does not teach every element of the claimed invention as recited in claims 1, as amended, 2, 4-7 and 16, as amended, and therefore cannot anticipate the claimed invention.

3. St. Ledger

Similarly, St. Ledger does not teach every element of the claimed invention as recited in claims 1, as amended, 2, 3, 4, as amended, 8, as amended, and 16, as amended, and therefore cannot anticipate the claimed invention. St. Ledger teaches an automatic water level monitoring system including housing 3 with an internal chamber 6 containing a rotatably adjustable over flow tube 15 and a vertically oriented water supply line 19 having a diaphragm valve 20 surrounded by an annular float 29 (column 2, lines 1-39). The heights of overflow tube 15 and valve 20 within the tank are not simultaneously adjustable. The position of the overflow tube within the tank is manually selected (column 2, lines 30-32). The height of valve 20 is separately adjusted, as follows. Valve 20 is attached to actuator bar 23 via support rods 24, 25, and rods 24, 25 are connected to an annular bracket 27 to which buoyant float 29 is secured (column 2, lines 47-62). The height of float 29 is adjusted by adjusting support rods 24, 25 (column 2, lines 50-68). Adjusting the support rods 24, 25, (and the height of float 29 of valve 20) does not affect the height of overflow tube 15, and adjusting the height of overflow tube 15 does not affect the height of float 29 or valve 20. Rather, the heights of valve 20 and overflow tube 15 are separately adjusted:

> It will be seen, therefore, that by suitable adjustment of the level of the float 29 within the chamber 6 the water level within the chamber 6 as well as in the swimming pool 8 may be automatically maintained within close tolerances about a general water level predetermined by the level adjustment of the float 29 upon its support rods 24 and 25. Also, by suitable rotational adjustment of the overflow tube 15 draining of excessive rain water falling into the pool 8 will occur above the selected maximum water level. (column 3, lines 1-12).

Accordingly, St. Ledger does not teach or suggest providing a tank containing an automatic fill device and an overfill drain device, wherein setting the height of one of the devices in the tank automatically sets the height of the other device, as recited in claim 1 from which claims 2-3 depend. St. Ledger fails to teach that the automatic fill device and overfill drain device are selectively movable for elevational adjustment relative to the tank as recited in claim 4, from which claims 5-7 depend. St. Ledger also fails to teach that the automatic fill device and overfill drain device are connected to each other or in a fixed relationship so that their movement within the tank is not restricted by any attachment to the tank, as recited in claims 1, 2, 8, and 16, or providing adjusting means for adjusting the height of both the automatic fill device and the overfill drain device as recited in claims 3 and 8. Accordingly, St. Ledger cannot anticipate the claimed invention.

Based on the foregoing, reconsideration and withdrawal of the rejections under 35 U.S.C. §§ 102(b) based on Whitten, Grewing, and St. Ledger are respectfully requested.

Rejection Under 35 U.S.C. § 103(a)

Claims 1-4, 8-11 and 16 have been rejected under 35 U.S.C. 103(a) as being unpatentable over St. Ledger in view of Maxhimer.

The mere fact that a prior art reference can be modified "should not have made the modification obvious unless the prior art suggested the desirability of the modification," and a modification which would render the prior art apparatus inoperable for its intended purpose does not establish a prima facie case of obviousness. *In re Gordon,* 221 USPQ 1125, 1127 (Fed. Cir. 1984) (citing *In re Imperato,* 179 USPQ 730, 732 (CCPA 1973) and *In re Schulpen,* 157 USPQ 52, 55 (CCPA 1968)). Further, where the prior art teaches away from the claimed invention, it cannot render the claimed invention obvious. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.,* 230 USPQ 416, 420 (Fed. Cir. 1986); *In re Gordon*, 221 USPQ at 1127.

As discussed above, St. Ledger fails to teach or suggest providing a tank (or skimmer) containing an automatic fill device and an overfill drain device, wherein movement of the devices within the tank is not restricted by any attachment to the tank, the height of the devices within the tank is simultaneously adjustable, and setting the height of one of the

devices automatically sets the height of the other device in the tank, as recited in claim 1, as amended, from which claims 2-4 depend, claim 8, as amended, claim 9, as amended, from which claims 10-11 depend, and claim 16, as amended. Rather, as described in detail above, movement of St. Ledger's valve 20 and overflow tube 15 is restricted by attachment to the tank and the heights of St. Ledger's valve 20 and overflow tube 15 within the tank cannot be simultaneously adjusted, rather, they must be separately adjusted. Therefore St. Ledger teaches away from the claimed invention.

St. Ledger also fails to teach providing adjusting means for adjusting the height of both the automatic fill device and the overfill drain device as recited in claims 3, 8 and 10. St. Ledger further fails to teach or suggest that the automatic fill and overfill devices are attached to an adjustable plate. While St. Ledger's housing 3 defines internal chamber 6, the height of the walls of housing 3 are not adjustable. Maxhimer fails to overcome these deficiencies.

Based on the foregoing, reconsideration and withdrawal of the rejection under 35 U.S.C. 103(a) are respectfully requested.

Allowed Subject Matter

Claims 12 and 14 have been objected to as being dependent upon a rejected base claim. Applicant respectfully submits that claims 12 and 14, depending from claims 1 and 9, as amended, are allowable.

Conclusion

All objections and rejections have been complied with, properly traversed, or rendered moot. Thus, it now appears that the application is in condition for allowance. Should any questions arise, the Examiner is invited to call the undersigned representative so that this case may receive an early Notice of Allowance.

Respectfully submitted,

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